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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,772	02/13/2001	Renee M. Kovales	RSW920000127US1	2011

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IBM CORPORATION
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EXAMINER
PHAN, JOSEPH T

ART UNIT	PAPER NUMBER
2653	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>18 September 2012</u>.
    ☐ A declaration(s)/affidavit(s) under **37 CFR 1.130(b)** was/were filed on _____.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on _____; the restriction requirement and election have been incorporated into this action.
4)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

5)☒ Claim(s) <u>92-115</u> is/are pending in the application.
    5a) Of the above claim(s) _____ is/are withdrawn from consideration.
6)☐ Claim(s) _____ is/are allowed.
7)☒ Claim(s) <u>92-115</u> is/are rejected.
8)☐ Claim(s) _____ is/are objected to.
9)☐ Claim(s) _____ are subject to restriction and/or election requirement.
* If any claims have been determined <u>allowable</u>, you may be eligible to benefit from the **Patent Prosecution Highway** program at a participating intellectual property office for the corresponding application. For more information, please see http://www.uspto.gov/patents/init_events/pph/index.jsp or send an inquiry to PPHfeedback@uspto.gov.

Application Papers

10)☐ The specification is objected to by the Examiner.
11)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
Certified copies:
    a)☐ All   b)☐ Some *   c)☐ None of the:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.
Interim copies:
    a)☐ All   b)☐ Some   c)☐ None of the: Interim copies of the priority documents have been received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
3) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
4) ☐ Other: _____.

DETAILED ACTION

After Board of Patent Appeals Decision, Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114 was filed in this application

after a decision by the Board of Patent Appeals and Interferences, but before the filing of a

Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil

action. Since this application is eligible for continued examination under 37 CFR 1.114 and the

fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to

37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114.

Applicant's submission filed on 09/18/2012 has been entered.

Response to Remarks

2.   In response to applicant's remarks filed on 09/18/2012, page 9 contending that the prior

art of record only teach segmenting a voicemail after it has been created. However as disclosed

in at least Hamel, an Originator can segment a voicemail(col.1 lines 30-35, col.2 lines 12-21,

col.3 lines 16-55, and col.4 lines 55-67).

Claim Rejections - 35 USC § 101

3.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

Claims 108-115 rejected under 35 U.S.C. 101 because the claims recite "a computer

program product" which is not clearly defined or limited in applicant's specification(e.g. the

phrase "so forth" is not limiting)

Computer-program product typically covers propagating signals per se in view of the ordinary

and customary meaning of machine/computer readable media, particularly when the

specification is silent. See MPEP 2111.01 and In re Nuijten, 500 F.3d 1346, 1356-

57(Fed.Cir.2007).

The USPTO recommends reciting "a Non-transitory tangible computer program product…" to

avoid non-statutory issues.

Appropriate clarification and/or correction is required.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of 35 U.S.C. 112(b):

(B) CONCLUSION.—The specification shall conclude with one or more claims particularly
pointing out and distinctly claiming the subject matter which the inventor or a joint inventor
regards as the invention.

The following is a quotation of 35 U.S.C. 112 (pre-AIA), second paragraph:

The specification shall conclude with one or more claims particularly pointing out and distinctly
claiming the subject matter which the applicant regards as his invention.

        Claims 92-115 rejected under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), second

paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject

matter which the inventor or a joint inventor, or for pre-AIA the applicant regards as the

invention.

        Claims 92, 100, and 108 lines 6-10 recites "said message" and "the message" which is

unclear and confusing if these are referring to "a segmented voicemail message" in line 1 or the

"a verbal message" in line 5 or the "recorded verbal message" in lines 7-9.

        Claims 92 and 108 line 3 recites "said voice mail system" which is unclear if this is

referring to a caller or recipient voicemail system as there is no antecedent basis.

        Claim 100 line 5 recites "said voice mail system" which is unclear if this is referring to

the first "a voicemail system" in line 1 or the second "a voicemail system" in line 3.

Claims 93-99, 101-107 and 109-115 are rejected based on being dependent on a rejected

base claim.

Appropriate clarification and/or correction is required.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or
> on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 92-115 rejected under 35 U.S.C. 102(b) as being anticipated by Hamel,

Patent #5,943,402.

Regarding claim 92, Hamel teaches a method of creating a segmented voicemail message

comprising:

receiving a phone call from a caller; recording a verbal message spoken by said caller to said

voice mail system via said phone call(col.1 lines 30-35, col.2 lines 12-21);

during the recording of said verbal message, receiving input from said caller that indicates at

least one division within said message(col.2 lines 12-21, col.3 lines 16-55, and col.4 lines 55-

67); and

storing the recorded verbal message as a voicemail message including at least one bookmark at a

division within the message that was entered by said caller during speaking of said

message(col.2 lines 12-21, col.3 lines 16-55, and col.4 lines 55-67).

Regarding claim 93, Hamel teaches the method of claim 92, wherein said input from said

caller comprises tone generated by pressing a button on a phone used by said caller to make said

phone call(col.2 lines 12-21).

Regarding claim 94, Hamel teaches the method of claim 92, wherein said input from said caller comprises a spoken command indicating a division within said message(col.2 lines 12-21, col.3 lines 16-55, and col.4 lines 55-67).

Regarding claim 95, Hamel teaches the method of claim 92, wherein said division within said message marks a change in a topic of said message(col.2 lines 12-21, col.3 lines 16-55, and col.4 lines 55-67).

Regarding claim 96, Hamel teaches the method of claim 92, further comprising replaying said recorded verbal message for a recipient, including skipping to said bookmark in response to input from said recipient to skip to said bookmark(col.1 line 61-col.2 line 21, col.3 lines 16-55, and col.4 lines 55-67).

Regarding claim 97, Hamel teaches the method of claim 92, further comprising receiving input from said caller indicating a degree of importance associated with at least one segment of said message which comprises said at least one division(col.1 line 61-col.2 line 21, col.3 lines 16-55, and col.4 lines 55-67; *One degree of importance which all messages are*).

Regarding claim 98, Hamel teaches the method of claim 92, Further comprising associating a bookmark with any one of a callback phone number, an email address or a Universal Resource Locator (URL) within the message(col.1 line 61-col.2 line 21, col.3 lines 16-55, and col.4 lines 55-67).

Regarding claim 99, Hamel teaches the method of claim 92, further comprising forwarding only a selected segment of said message to a designated recipient, said segment of said message being marked by a said division within said message(col.1 line 61-col.2 line 21,

col.3 lines 16-55, and col.4 lines 55-67).

Regarding claim 100, Hamel teaches a voicemail system for producing a segmented

voicemail message comprising:

a voicemail system configured to: receive a phone call from a caller; record a verbal message

spoken by said caller to said voice mail system via said phone call(col.1 lines 30-35, col.2 lines

12-21);

during the recording of said verbal message, receive input from said caller that indicates at least

one division within said message(col.2 lines 12-21, col.3 lines 16-55, and col.4 lines 55-67); and

store the recorded verbal message as a voicemail message including at least one bookmark at a

division within the message that was entered by said caller during speaking of said

message(col.1 line 61-col.2 line 21, col.3 lines 16-55, and col.4 lines 55-67).

Regarding claim 101, Hamel teaches the voicemail system of claim 100, wherein said

input from said caller comprises tone generated by pressing a button on a phone used by said

caller to make said phone call(col.2 lines 12-21).

Regarding claim 102, Hamel teaches the voicemail system of claim 100, wherein said

input from said caller comprises a spoken command indicating a division within said

message(col.2 lines 12-21, col.3 lines 16-55, and col.4 lines 55-67).

Regarding claim 103, Hamel teaches the voicemail system of claim 100, wherein said

division within said message marks a change in a topic of said message(col.1 line 61-col.2 line

21, col.3 lines 16-55, and col.4 lines 55-67).

Regarding claim 104, Hamel teaches the voicemail system of claim 100, said system

being further configured to replay said recorded verbal message ~br a recipient, including

skipping to said bookmark in response to input from said recipient to skip to said bookmark(col.1 line 61-col.2 line 21, col.3 lines 16-55, and col.4 lines 55-67).

Regarding claim 105, Hamel teaches the voicemail system of claim 100, said system being further configured to receive input from said caller indicating a degree of importance associated with at least one segment of said message which comprises said at least one division(col.1 line 61-col.2 line 21, col.3 lines 16-55, and col.4 lines 55-67; *One degree of importance which all messages are).*

Regarding claim 106, Hamel teaches the voicemail system of claim 100, said system being further configured to associate a bookmark with any one of a callback phone number, an email address or a Universal Resource Locator (URL) within the message(col.1 line 61-col.2 line 21, col.3 lines 16-55, and col.4 lines 55-67).

Regarding claim 107, Hamel teaches the voicemail system of claim 100, said system being further configured to forward only a selected segment of said message to a designated recipient, said segment of said message being marked by a said division within said message(col.1 line 61-col.2 line 21, col.3 lines 16-55, and col.4 lines 55-67).

Regarding claim 108, Hamel teaches a computer program product comprising program code embodied in a computer-useable storage medium, said program code, when executed, causing a voicemail system to:

receive a phone call from a caller; record a verbal message spoken by said caller to said voice mail system via said phone call(col.1 line 61-col.2 line 21);

storing the recording of said verbal message, receive input from said caller that indicates at least one division within said message(col.1 line 61-col.2 line 21); and

store the recorded verbal message as a voicemail message including at least one bookmark at a

division within the message that was entered by said caller during speaking of said

message(col.1 line 61-col.2 line 21, col.3 lines 16-55, and col.4 lines 55-67).

Regarding claim 109, Hamel teaches the computer program product of claim 108,

wherein said input from said caller comprises tone generated by pressing a button on a phone

used by said caller to make said phone call(col.1 line 61-col.2 line 21).

Regarding claim 110, Hamel teaches the computer program product of claim 108,

wherein said input from said caller comprises a spoken command indicating a division within

said message(col.1 line 61-col.2 line 21, col.3 lines 16-55, and col.4 lines 55-67).

Regarding claim 111, Hamel teaches the computer program product of claim 108,

wherein said division within said message marks a change in a topic or said message(col.1 line

61-col.2 line 21, col.3 lines 16-55, and col.4 lines 55-67).

Regarding claim 112, Hamel teaches the computer program product of claim 108, said

program code, when executed, further causing a voicemail system to replay said recorded verbal

message for a recipient, including skipping to said bookmark in response to input ti'om said

recipient to skip to said bookmark(col.1 line 61-col.2 line 21, col.3 lines 16-55, and col.4 lines

55-67).

Regarding claim 113, Hamel teaches the computer program product of claim 108, said

program code, when executed, further causing a voicemail system to receive input from said

caller indicating a degree of importance associated with at least one segment of said message

which comprises said at least one division(col.1 line 61-col.2 line 21, col.3 lines 16-55, and col.4

lines 55-67; *One degree of importance which all messages are).*

Regarding claim 114, Hamel teaches the computer program product of claim 108, said

program code, when executed, further causing a voicemail system to associate a bookmark with

any one of a callback phone number, an email address or a Universal Resource Locator (URL)

within the message.

Regarding claim 115, Hamel teaches the computer program product of claim 108, said

program code, when executed, timber causing a voicemail system to forward only a selected

segment of said message to a designated recipient, said segment of said message being marked

by a said division within said message(col.1 line 61-col.2 line 21, col.3 lines 16-55, and col.4

lines 55-67; *One degree of importance which all messages are).*

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to JOSEPH T. PHAN whose telephone number is (571)272-7544.

The examiner can normally be reached on Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/JOSEPH T PHAN/
Primary Examiner, Art Unit 2653